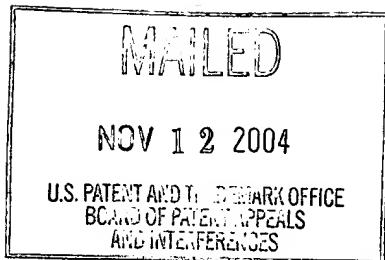


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte ALEX S. TOBACK

Appeal No. 2004-2329
Application No. 09/639,599

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

REMAND TO THE EXAMINER

Alex S. Toback appeals from the final rejection (Paper No. 5, mailed December 4, 2002) of claims 1 to 24, all of the claims pending in the application. Before considering the appeal on its merits, we find it once again necessary to remand the application to the examiner.¹

¹ This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

BACKGROUND

In the final rejection, the examiner rejected the claims as follows:

1. Claims 1 to 24 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art² in view of Orowan³.
2. Claims 4 to 7 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Orowan as applied to claim 1 above, and further in view of Good et al.⁴ (Good).
3. Claims 8 to 15 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Orowan and Good.
4. Claims 18, 21 and 24 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Orowan as applied to claims 16, 19 and 22 above, and further in view of Good.

In the brief (Paper No. 9, filed June 2, 2003), the appellant set forth his arguments as to why the rejections set forth in the final rejection were in error.

² The appellant admitted in the application (specification, page 1; Figures 1(a), 2 and 9) that it was known in the art to use numerous fasteners to connect a steel stiffening strap to a gusset plate (Admitted Prior Art).

³ U.S. Patent No. 3,655,424 issued April 11, 1972.

⁴ U.S. Patent No. 4,426,425 issued January 17, 1984.

In the answer (Paper No. 10, mailed July 2, 2003), the examiner rejected the claims as in the final rejection and added a further rejection (pp. 4-5) of claims 1 to 3, 16, 17, 19, 22 and 23 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Orowan.⁵

In our first remand (Paper No. 12, mailed November 24, 2003), this panel of the Board:

(1) Noted that all the claims under appeal recite that the adhesive is curable at room temperature. However, in the rejections then before us in this appeal the examiner had not either (i) determined that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the Admitted Prior Art by using an adhesive curable at room temperature⁶ to supplement the fasteners in connecting the steel stiffening strap to the gusset plate; or (ii) set forth a rationale supporting a conclusion that the product-by-process limitation that the adhesive is curable at room temperature does not affect the product itself (i.e., the claimed connection system or assembly) and therefore does not impart patentability to the product. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); and

⁵ The appellant did not file a reply brief.

⁶ The appellant admits (specification, p. 3) that an adhesive curable at room temperature is known. However, the examiner had not applied this known curable adhesive in the rejections set forth in the final rejection and answer (Paper Nos. 5 and 10).

(2) Remanded the application to the examiner to supply a supplemental answer which sets forth a rationale as to why the **applied prior art** would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified the Admitted Prior Art by using an adhesive curable at room temperature to supplement the fasteners in connecting the steel stiffening strap to the gusset plate; and/or set forth a rationale as to why the product-by-process limitation that the adhesive is curable at room temperature does not affect the product itself.

In a supplemental answer (Paper No. 13, mailed January 21, 2004), the examiner set forth a rationale as to why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the Admitted Prior Art by using an adhesive curable at room temperature to supplement the fasteners in connecting the steel stiffening strap to the gusset plate in view of **additional prior art**.⁷ The examiner also made the statement that the limitation that the adhesive is curable at room temperature does not affect the product itself and does not impart patentability to the product.

⁷ The appellant's admission (specification, p. 3) that an adhesive curable at room temperature is known.

ACTION

We view all the rejections set forth in the supplemental answer as new grounds of rejection since they rely on prior art⁸ not previously applied. 37 CFR § 1.193(a)(2), in effect when the supplemental answer was written⁹, provided that "[a]n examiner's answer must not include a new ground of rejection."

We remand this application to the examiner to ascertain whether or not the new grounds of rejection set forth in the supplemental answer were permitted under the rules of practice then in effect. If the new grounds of rejection set forth in the supplemental answer were not permitted under the rules of practice then in effect, the examiner should take appropriate action to withdraw the supplemental answer and then respond to our initial remand.¹⁰ If the new grounds of rejection set forth in the supplemental answer were permitted under the rules of practice then in effect, the examiner should set forth an explanation as to why a new ground of rejection was permitted in a supplemental answer

⁸ Id.

⁹ 37 CFR § 1.193 was removed effective September 13, 2004. See 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004). 37 CFR § 41.39(a)(2) now permits an examiner's answer to include a new ground of rejection. 37 CFR § 41.43(a)(2) provides that a supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

¹⁰ In responding to our initial remand, we note that the examiner's statement in the supplemental answer that the limitation that the adhesive is curable at room temperature does not affect the product itself and does not impart patentability to the product failed to set forth a rationale supporting that conclusion (e.g., an explanation of why the curing process would not be discernable from the end product).

under the rules of practice then in effect, obtain any necessary approvals for the new grounds of rejection, and permit the appellant to respond to the new grounds of rejection.¹¹

CONCLUSION

To summarize, the application has been remanded to the examiner for further action.


¹¹ For example, the appellant could be given a time period of two months to exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new grounds of rejection:


- (1) Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR § 1.111 with or without amendment or submission of affidavits or other evidence.
- (2) Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR § 41.41. A reply brief may not be accompanied by any amendment, affidavit or other evidence.

This application, by virtue of its "special" status, requires immediate action, see
MPEP § 708.01.

REMANDED


IRWIN CHARLES COHEN
Administrative Patent Judge


LAWRENCE J. STAAB
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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ALIX YALE & RISTAS LLP
750 MAIN STREET
SUITE 1400
HARTFORD, CT 06103

JVN/jg